

REMARKS

10 Applicant herewith affirms election of Invention I, claims 1-21 and 26-29 for prosecution at this time.

 Claims 22-25 stand withdrawn.

15 Claims 1-21 stand rejected under 35 USC Section 112 as allegedly indefinite. The Examiner finds inaccurate the language “substantially figure eight shape having a first loop and a second loop.” While the use of a “figure eight shape” is supported by the language of the specification and is thereby accurate and proper for purposes of claim language, applicant is willing to amend the claims in clarification. More particularly, the subject language has been amended to
20 reference an hourglass shape with a first lobe and a second lobe. Applicant respectfully submits such language is supported by the drawings, the shape in question having a generally hourglass shape with first and second lobes. Accordingly, this amendment represents a change in language only and not in substantive meaning relative to claim scope or validity.

25 In claim 14, the Examiner finds applicant’s intent unclear in the language “said first loop extending a first distance generally parallel to a front-to-back dimension and away from said line ... from said line.”

Applicant respectfully traverses this rejection and provides the following clarification.

Viewing the bag in cross section to portray the hourglass shape, e.g., viewing the bag from the side, the “line” goes from top to bottom dividing the front and the rear for the bag, including a division of the front and rear of each of the first and second lobes. The “first distance” corresponds to the front-to-back thickness of the first lobe, e.g., a length parallel to a “front-to-back” dimension through the first lobe. The “second distance” corresponds to the front-to-back thickness of the second lobe, e.g., also a length parallel to a “front-to-back” dimension but through the second lobe. Setting the first distance as less than the second distance sets the thickness of the first lobe as less than the thickness of the second lobe.

Claims 1-4 and 10-15 stand rejected as allegedly unpatentable over Rothberg in view of Wood et al. The Examiner cites Wood “to show a bag with different width.” The Examiner cites Rothberg for showing a container with a top and an interior compartment, the top having “an opening to provide access thereof.” The Examiner then purports as obvious “to provide any desired shape for the container.”

Applicant finds fatally ambiguous the Examiner’s characterization of Wood. In particular, applicant has no basis to judge what is taken as “width” in the cited reference. Also, applicant has no basis to determine to what “different width” means, e.g., different relative to what other elements of the Wood device. Is “width” to be taken as parallel to a front-to-back dimension, e.g., forward and rearward relative to a user’s body when wearing the subject device, or to be taken as parallel to a side-to-side dimension, e.g., laterally relative to a user wearing the subject device?

Without further clarification, applicant has no basis to judge how it is that the Examiner proposes to combine the “different width” of the cited Wood reference with the elements of the cited Rothberg reference and, therefore, no fair opportunity to respond to the rejection of claims 1-4 and 10-15.

Accordingly, applicant respectfully requests that the Examiner either properly restate the rejection of claims 1-4 and 10-15 in such manner as to permit applicant a fair opportunity to respond or that the Examiner withdraw the rejection of claims 1-4 and 10-15.

5 Furthermore, applicant respectfully traverses the Examiner's rejection of claims 1-4 and 10-15 for failure to set forth a proper combination of the cited references. The Examiner fails to expressly combine the cited Rothberg and Wood references, improperly leaving applicant to speculate as to how and what features of the cited references are to be combined under 35 USC Section 103. 35 USC Section 103 requires a clear *prima facie* statement of obviousness as to
10 how the cited references are to be combined. For example, "it would be obvious to combine the X1 feature of reference X in the Y1 structure of reference Y..."

 In the present case, the Examiner merely inventories the purported features of the two references and fails to state a proper Section 103 combination thereof. Without a specific
15 allegation of obvious combination, applicant cannot properly respond to the Examiner's purported rejection.

 Accordingly, the rejection of claims 1-4 and 10-15 as unpatentable over the combination of Rothberg and Wood must be withdrawn or restated in such manner to permit applicant a fair
20 opportunity to respond, i.e., specify how and what features of each reference are combined under 35 USC Section 103.

 Furthermore, the Examiner relies upon Rothberg to show a container with a top and an interior compartment, the top having an opening to provide access, and the container being of "any
25 desired shape."

 Rothberg does not disclose, suggest, or provide any motivation whatsoever to provide the subject container "in any desired shape."

Rothberg illustrates only an inflatable cylindrical container. Rothberg suggests a limited set of additional shapes: spherical (beach ball) and rectangular (seat cushion) (see column 1, line 34 and thereafter). Nowhere does Rothberg suggest that the container be “any desired shape.” In fact, the container itself has no inherent shape or structure. In the words of Rothberg:

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Of course being of flexible material it would normally appear more or less deformed by the pull of gravity on its walls or by the shape of items it contains. (Column 2, lines 3-5)

10 Applicant respectfully submits that the Examiner’s unfounded assertion that the Rothberg container “be of any shape” flies in the face of the Examiner’s obligation to present *prima facie* obviousness.

15 To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable
20 expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP Section 2143.

25 No cited reference includes suggestion or motivation to adopt the claimed bag geometry, e.g., hourglass shape. The only hourglass shape in the record of the present application is found in applicant’s disclosure. Even if combined, the cited references fail to include all claim limitations, e.g., fail to include the claimed bag geometry.

30 The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

MPEP 2143[01]

The fact that a container could be shaped as proposed by the Examiner does not make obvious such modification without some suggestion or motivation in the cited reference to do so.

In the present case, the Rothberg container serves its purpose and stated objectives, i.e., a flexible-walled container selectively inflatable to serve as a cylindrical head cushion, spherical beach ball, or rectangular seat cushion. A Rothberg container of other shapes, and certainly “any desired shape” does not serve these specific purposes and stated geometries and therefore falls outside any modification permissible under 35 USC Section 103.

Accordingly, the Examiner’s proposed modification of Rothberg goes well beyond the stated suggestions and motivations presented in the Rothberg disclosure and cannot support a 35 USC Section 103 rejection of claims 1-4 and 10-15.

Claims 1-21 stand rejected as allegedly unpatentable over Dees in view of Wood. Again, the Examiner cites Wood “to show a bag with different width.” Dees is cited to show “a carrying container with an interior compartment” and a top having “an opening to provide access thereof.” The Examiner then contends that the “top left portion is thinner than the bottom portion.” Acknowledging that Dees fails to show the claimed “figure eight” shape, the Examiner asserts as obvious “to provide any desired shape for the container.”

Again, applicant finds fatally ambiguous the characterization of Wood as discussed above.

Applicant also finds fatally ambiguous what the Examiner means by the “top left portion is thinner than the bottom portion” in the Dees reference. Applicant respectfully asks that the Examiner identify such elements by reference numeral, text citation, and figure.

The Dees reference fails, as does the proposed combination of Dees and Woods, for the reasons discussed above relative to the Rothberg reference. More particularly, the Examiner has failed to combine the cited references in such manner as to allow applicant fair opportunity to

respond to a specific combination of elements taken from each reference. The Examiner's unfounded assertion that the Dees container "be of any shape" flies in the face of the Examiner's obligation to present *prima facie* obviousness. Without some suggestion or motivation to do so as found in the cited Dees reference, the Examiner has failed to establish *prima facie* obviousness.

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Claims 26-29 stand rejected under 35 USC Section 103(a) as unpatentable over official notice. The Examiner contends "It is conventional to find a luggage or a purse type container that has a molded interior with foam between an exterior layer and the molded portion to provide cushion to the article therein. The luggage or purse actually has a strap or handle for carrying purpose."

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Applicant respectfully traverses the Examiner's reference to official notice in support of the above rejection.

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It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

MPEP 2144[03]

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While containers may include molded resilient structures and foam padding, applicant herewith challenges whether such elements as claimed are instantly and unquestionably well-known in the particular arrangement and geometry claimed.

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Applicant respectfully submits that the Examiner cannot make final the rejection based on official notice without presentation of documentary evidence of such prior art individually or in combination making the claimed structure as a whole obvious under 35 USC Section 103.

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Applicant does not simply claim "a luggage or a purse type container that has a molded interior with foam between an exterior layer and the molded portion to provide cushion to the article therein." Additional limitations, e.g., "said first portion having a front-to-back thickness less than

a front-to-back thickness of said second portion” and “padding between said exterior surface material and said molded resilient structure” must be equally obtainable by official notice, i.e., the claimed combination as a whole must be capable of instant and unquestionable demonstration as being well-known.

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Furthermore, the Examiner’s rendition of official notice lacks inherent structural sense. More particularly, the placement of the foam outside the molded structure, i.e., “between said exterior surface material and said molded resilient structure”, cannot protect items within the molded resilient structure. Accordingly, the statement of official notice is not capable of instant and unquestionable demonstration as being well known as it lack internal logical sense.

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Finally, with respect to the Examiner’s arguments as a whole, applicant claims a bag of particular geometry and the Examiner has not cited a single item of prior art having or suggesting such geometry. Merely alleging that a container can be “of any desired shape” cannot support a 35 USC Section 103 rejection. At minimum, applicant respectfully submits that the body of cited prior art at least show in one reference the claimed bag geometry. Beyond that, the cited art must be properly combinable under 35 USC Section 103. Without at least one reference showing a container having the claimed geometry, applicant respectfully submits that the Examiner cannot establish *prima facie* obviousness. As the MPEP Section 2143.03 clearly requires:

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To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

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In all outstanding rejections, the Examiner has failed to cite prior art or official notice including teachings or suggestions relative to applicants claimed bag geometry, e.g., an hourglass

shape with one lobe larger than the other, and therefore cannot establish obviousness under 35 USC Section 103.

Accordingly, applicant respectfully submits that the Examiner must cite prior art showing a container of the claimed geometry or withdraw all outstanding Section 103 rejections.

In light of the above amendment and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the US Postal Service as First Class Mail, in an envelope addressed to: Commissioner for Patents PO BOX 1450 Alexandria, VA 22313-1450, on the date indicated below.

Date

11/8/04

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